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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Thomas SALUTZKI

Serial No.: 10/518,702

Filed: December 20, 2004

For: Drive Device for Opening or Closing a Door or
Similar

Examiner: Williams, Thomas J.
Group Art: 3683

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Responsive to the Final Office Action dated January 17, 2008, and the Advisory Action dated April 4, 2008, applicant hereby requests review of the final rejection by a panel of examiners. A Notice of Appeal is enclosed herewith. A check in the amount of \$510 in payment of the notice of appeal fee is enclosed herewith

Claims 9, 10 and 12-16 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,618,899 (*Ginzel*), which incorporates U.S. Patent No. 4,019,220 (*Lieberman*).

Independent claim 9 recites, *inter alia*, "a piston made of polyoxymethylene plastic, the piston having a toothed rack... wherein the toothed rack is made of metal and is embedded in

the piston by molding the polyoxymethylene plastic around the rack so that the rack and the piston form a one-piece element."

On page 3 of the Office Action, the Examiner contends that *Lieberman* discloses a rack which is made of metal and a piston which is molded around the rack. Applicant disagrees.

Lieberman teaches a piston assembly 16 formed by a main body 26 and a rack 28 (*see*, col. 1, ll. 38-44). *Lieberman* explicitly teaches that the main body 26 and the rack 28 are made separately and coupled together. In one example, the rack 28 is supported on a tripodal support formed by bosses 52, 54, 56 (*see, e.g.*, col. 3, ll. 35-37 and Fig. 1-3). There is no teaching or suggestion in *Lieberman* that the main body 26 is molded around the rack 28 as asserted in the Office Action.

Also on page 3 of the Office Action, the Examiner considers the claim features "[the toothed rack being] embedded in the piston by molding the polyoxymethylene plastic around the rack" as a process step and takes the position that such "process step can not be relied upon for determining patentability in an apparatus claim." In support of this, the Examiner relies on MPEP 2113, which reads in part as follows:

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. *See, e.g., In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.).

The leading cases in this area include *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), and *In re Pilkington*, 162 USPQ 145, 147 (CCPA 1969). These cases explain when a "product-by-process" claim is patentable. Basically, in order to be patentable, the product must have

structural characteristics that distinguish it from the prior art. It cannot be the same as or obvious from the prior art product. In *Thorpe*, the product, though made by a different process, was no different than the product made by a prior art process. Thus, the claims were held to be unpatentable. In *Pilkington*, on the other hand, the product (plate glass manufactured on a bed of molten metal), the claims were found to be patentable because the glass itself was different from the prior art plate glass made with rollers. This is the seminal case on product-by-process claims, and is still good law.

Product-by-process claims are useful when the process of manufacture imparts unique and useful characteristics to a product, but there is no easy way to describe those characteristics besides referring to the manufacturing process. Such was the case in *Pilkington*, and such is the case here. The molding of the plastic piston around the rack creates an integrated one-piece structure wherein the molding of the plastic around the rack would be readily apparent to one skilled in the art. At the same time, there is no convenient way to describe this structure other than by reference to the manufacturing process.

Neither *Ginzle* nor *Lieberman* suggests a plastic piston which is molded around a metal rack. *Ginzle* discloses plastic piston with a plastic rack, and *Lieberman* discloses a metal rack which is attached to a piston after the two components have been separately manufactured. Neither reference suggests molding a plastic piston around a metal rack, and consequently does not suggest the structure created by this process.

The Federal Circuit has stated that "anticipation requires the disclosure in a single prior art reference of each element in the claim under consideration". *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). The Federal Circuit has also stated that "anticipation requires the presence in a single prior art reference disclosure of each and every

element of the claimed invention, *arranged as in the claim*. Since *Ginzel* (which incorporates *Lieberman*) does not disclose all of the elements in the claim under consideration, arranged as in the claim, it does not represent an anticipation.

Since the examiner has not established a *prima facie* case of unpatentability, then without more the applicant is entitled to the grant of a patent. *In re Oetiker*, 977 F.2d 1443, 22 USPQ 2d 1443 (Fed. Cir. 1992).

Claims 9, 10 and 12-16 also stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 00/36255 (which is the International Priority Application of *Ginzel*) in view of U.S. Patent No. 6,077,908 (*Yahiro*). This rejection is respectfully traversed.

As is discussed in detail above, *Ginzel/Lieberman* fails to suggest an important structural feature features of independent claim 9. *Yahiro* is cited in the Office Action as disclosing using polyoxymethylene plastic to make a variety of products and does not remedy the above discussed deficiencies of *Ginzel/Lieberman*. As a result, the combination of *Ginzel* and *Yahiro* also fails to teach or suggest the above recited claim features of independent claim 9.

The advisory action adds nothing to establish a *prima facie* case of anticipation or obviousness. Here the examiner points out that the figure does not illustrate the toothed rack, which to his way of thinking would somehow illustrate the qualities of a piston molded around the rack. However, as pointed out above, product-by-process limitations are used where the structural qualities are not otherwise readily defined. Likewise, they are not readily illustrated. The examiner also expresses the opinion that the process recited by applicant does not in fact provide unique or useful characteristics beyond that of the prior art, since the remarks are not supported by the disclosure. This statement misapprehends the law, which requires that the prior art disclose the claimed features. Since the prior art does not disclose “a piston made of polyoxymethylene

plastic, the piston having a toothed rack... wherein the toothed rack is made of metal and is embedded in the piston by molding the polyoxymethylene plastic around the rack so that the rack and the piston form a one-piece element", the absence of a detailed discussion in applicant's specification does not detract from patentability.

In view of the foregoing, withdrawal of the rejections of independent claim 9 under 35 USC 102(e) and 35 U.S.C. §103(a) are respectfully requested.


Dependent claims 10 and 12-16 are allowable for at least the same reasons that amended independent claim 9 is allowable.

Since a rack screwed in place in a recess cannot anticipate a rack embedded in plastic by molding plastic around it, reversal of the rejections and early allowance are solicited.

It is believed that no additional fees or charges are required at this time in connection with the present application. However, if any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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